



UNITED STATES PATENT AND TRADEMARK OFFICE

colh

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,745	08/28/2003	Jyunichi Nakamura	060914-0117-US	5720

9629 7590 05/27/2005

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT PAPER NUMBER

2826

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/649,745	Applicant(s) NAKAMURA ET AL.	
	Examiner Alexander O. Williams	Art Unit 2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,11,12,14,15 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,11,12,14,15 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2826

Serial Number: 10/649745 Attorney's Docket #: 060914-117-US
Filing Date: 8/28/2003; claimed foreign priority to 10/31/2001

Applicant: Nakamura et al.

Examiner: Alexander Williams

This application is a divisional application of serial # 10/281163, filed 10/28/02.
This application is now U.S. Patent # 6,759,739.

Applicant's Amendment filed 3/8/05 has been acknowledged.

Applicant's election without traverse of the species of figures 1, 2 and 8 (claims 1, 12, 13, 14 and 15), filed 9/22/04, has been acknowledged. However, claim 15 depends from a nonelected claim 5 and will not be examined. Claims 1 and 12-14 was examined.

This application contained claims 5, 6, 7, 8, 15 and 16 to 21 drawn to an invention non-elected without traverse.

Claims 2-11, 13 and 16-21 have been canceled.

Claims 1, 12, 14, 15 and 22 to 26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 15, it is confusing to what is meant by "in the form of **bump** so that the tip." Should this be in the form a bump"? (Note: non-elected claim 15 has the same problem)

In claim 1 language of "wherein a reinforcing sheet is respectively joined to the face for mounting a semiconductor element thereon and the face for external connection terminals of the multilayered substrate body". Does this claim that the reinforcing layer is actually on both faces or on just the one face?

Any of claims 1, 12, 14, 15 and 22 to 26 not specifically addressed above are rejected as being dependent on one or more of the claims which have been specifically objected to above.

Art Unit: 2826

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 14 and 15, **insofar as they can be understood**, are rejected under 35 U.S.C. § 102(b) as being anticipated by Kamoi (Japan Patent Application # 11-74649).

1. Kamoi (figures 1 to 2d) specifically figure 1 show a multilayered substrate **1** for a semiconductor device, comprising: a multilayered substrate body **1** formed of a plurality of conductor layers **2** and insulation layers **1a,1b**, and having a face for mounting a semiconductor element **5** thereon and another face for external connection terminals **3b**, the face for mounting a semiconductor element with comprising pads **3a,7** through which the substrate is connected to the semiconductor element to be mounted thereon,

and the face for external connection terminals comprising pads **3b** through which the substrate is connected to an external electrical circuit, wherein a reinforcing sheet **6a,6b** is respectively joined to the face for mounting a semiconductor element thereon and the face for external connection terminals of the multilayered substrate body, and wherein the pads provided at the face for mounting a semiconductor element **5** thereon are in the form of bump so that the tip of the pad protrudes from the face for mounting a semiconductor element of the multilayered substrate body.

Response

Applicant's arguments filed 3/8/05 have been fully considered, but are moot in view of the new grounds of rejections detailed above.

The insertion of Applicant's additional claimed language, for example, "in claims 1, 15 and new claims 22-26" cause for further search and consideration to make this action final.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY

Art Unit: 2826

PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE
OF THIS FINAL ACTION.

The listed references are cited as of interest to this application, but not applied at this time.

Field of Search	Date
U.S. Class and subclass: 257/700,701,758,790,698,704,707,710,680,774,712,7137 20,787,788,737,738,717	12/3/04 5/25/05
Other Documentation: foreign patents and literature in 257/700,701,758,790,698,704,707,710,680,774,712,7137 20,787,788,737,738,717	12/3/04 5/25/05
Electronic data base(s): U.S. Patents EAST	12/3/04 5/25/05

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander O Williams whose telephone number is (571) 272 1924. The examiner can normally be reached on M-F 6:30 AM -7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272 1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2826

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander O Williams
Primary Examiner
Art Unit 2826

AOW
5/25/05